

Beiersdorf 637.2-HCL
100718-197
6713-Dr. WI-ar

REMARKS

Amendment to the Claims

No amendments have been made to claims 16-30. Claim 31 is the same as claim 16 but the phrase "consisting essentially of" has been entered instead of "comprising". It is believed that no new matter has been added.

Double-Patenting Rejection

- (1) Claims 16, 19 and 23 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting rejection over application SN: 09/641,013. A terminal disclaimer has been filed over this application which should render this provisional rejection moot.
- (2) Claims 16, 19 and 23-25 were rejected under the judicially created doctrine of obviousness-type double patenting rejection over Gers-Barlag et al. (U.S. Patent 6,592,883) in view of Fänger et al. (U.S. Patent 6,153,204).

A terminal disclaimer has been filed over U.S. Patent 6,592,883. However, in light of *Festo*, the applicants state for the record that the above rejection is in error and the terminal disclaimer is being filed for a obviousness-type double patenting rejection over U.S. Patent 6,592,883 alone.¹

35 U.S.C. 103(a) rejection

Claims 16-30 were rejected as being obvious over Fänger et al. (U.S. Patent 6,153,204) in view of Msika et al. (U.S. Patent 5,939,054)

Introduction

The applicants and the examiner have essentially maintained their positions during the last couple of office actions. While the applicants maintain their previous positions, a different approach to the

¹ MPEP 804 states "Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the claimed subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude the granted by a patent.....When considering whether an invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.

As the use of the secondary reference does not appear to be for "dictionary" purposes, the combination of references is presumed to constitute a *Schneller*-type nonstatutory double patenting rejection. MPEP 804 in addressing these types of rejections states "Non-statutory double patenting rejections based on *Schneller* will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*...the examiner should first consult with his or her supervisor (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained..." There is no indication from the Office Action

Beiersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

rejection is presented below in addition to a re-emphasis of a difference which is not addressed by the prior art.

Applicants' invention is directed toward a cosmetic or dermatological stick preparation

The applicants' invention is directed toward cosmetic or dermatological stick preparations which are finely disperse water-in-oil emulsions. As indicated on page 7, lines 21-27 of the specification, traditional emulsions were unsuitable for stick preparation. It is the applicants' specific combination of elements as exemplified by their claim 16 which allows for a water-in-oil emulsion to be formulated into a stick preparation. Applicants' claim 16 can be broken down into the following elements:

- (1) cosmetic or dermatological stick preparation,
- (2) a finely disperse water-in-oil emulsion, comprising
- (3) an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,
- (4) a water phase,
- (5) at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and
- (6) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.

The examiner relies on the teachings of Fänger et al. as the primary reference to support her holding of obviousness, but this reference merely confirms what was already known about the unsuitability of emulsions to formulate stick preparations. Example 13 of Fänger et al. shows a lipcare stick but this is not a water-in-oil emulsion. Example 14 of Fänger et al. shows a water-in-oil emulsion stick but requires 3.5% by weight of an emulsifier (i.e. polyglyceryl-3-dioleate).

The examiner's characterization of Fänger et al. appears to indicate that all she believes is missing from this reference is a teaching of the use of a modified phyllosilicate pigment particle. However, while this element (element (5) above) is indeed missing from Fänger et al., what is also missing from Fänger et al. is a teaching or suggestion for the remaining five elements to be used in combination with each other.

that these procedures were performed.

Beiersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

Fänger et al. does not teach or suggest the applicants' invention minus element (5)

When considering the teachings of Fänger et al. as a whole, it is clear that their invention is directed toward the use of hydrophilic starch esterified with one or more n-octenylsuccinate radicals. While the examiner is correct in asserting that determination of obviousness is not limited to preferred embodiments but extends to the entire disclosure for what it fairly teaches, when applying this standard to the Fänger et al. reference, one of ordinary skill in the art would not be directed toward a stick preparation which simultaneously contains all of the elements of the applicants' invention with the exception of element (5).

It has long been held that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))² When considering the Fänger et al. reference as a whole, there is no teaching or suggestion for a stick preparation which includes each of the elements of the applicants' invention with the exception of element (5). It is only through improper picking and choosing of elements from within Fänger et al. that one of ordinary skill in the art would be able to approximate the applicants' claimed stick preparations.

Applicants' stick preparation would not have been obvious without guidance from applicants' claims

MPEP 2141.01 sect. III discusses the need to determine the content of the prior art at the time the invention was made to avoid hindsight. See also *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) which discusses in length about the standard with which prior art references should be viewed:

"Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art.' *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.' *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And 'teachings of references can be combined *only* if there is some suggestion or incentive to do so.' *Id.* Here the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination...

² see also *In re Davis*, 26 F.3d 139, (Fed. Cir. 1994); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986); *In re Mercier*, 515 F.2d 1161, 185 USPQ 774 (CCPA 1975); *In re Kamm*, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972); *In re Umbricht*, 404 F.2d 386, 160 USPQ 15 (CCPA 1968); see also *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("...Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.")

Beiersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention *and cast the mind back to the time the invention was made...* to occupy the mind of one skilled in the art *who is presented only with the references*, and who is normally guided by the then-accepted wisdom in the art.' *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 5 USPQ2d 1599, 1600.

In *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993) (relying on *Fine*) it was further stated that "[a]bsent such suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reasoning is impermissible." *Id.* at 1029.

As *In re McLaughlin* (see MPEP 2145, section X. A.) is often reflexively invoked when confronted with hindsight reconstruction arguments, it is important to point out that the ruling in *Fine, Texas Instruments* and *McLaughlin* are not incompatible and are different ways of expressing the same concept, i.e. applicants' specification and claims cannot be used as a template to determine whether: (1) the primary reference could have been modified; and (2) if the primary reference could have been modified that there was sufficient suggestion and motivation to do so. Applying these standards to the facts at hand, the question becomes:

"As of 17 August 2000 (the filing date of this application), would one of ordinary skill in the art have been directed or have had motivation to modify the teachings of Fänger et al. to arrive at the presently claimed invention when not having the luxury of the applicants' claims to provide them with any guidance as to how to modify Fänger et al.'s teachings?"

The answer is no.

As indicated in the section above, one of ordinary skill in the art would not even had a teaching or suggestion to provide a stick preparation which has five of the six elements of the applicants' claimed invention. Given that the focus of the Fänger et al. reference was on the use of hydrophilic starch esterified with one or more n-octenylsuccinate radical, it is unclear how one of ordinary skill in the art would be able to approximate the applicants' stick preparation have the Fänger et al. reference before him but without the benefit of a copy of the applicants' claims before them.

Similarly, the various ingredients which can be combined with the hydrophilic starch esterified with one or more n-octenylsuccinate radical represent a limitless number of permutations to be considered by one of ordinary skill in the art. It has previously been held that "...the board said, referring to the

Belersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *In re Rice*, 178 USPQ 478, 480 (CCPA 1973).

No teaching, suggestion or motivation to combine the references

Even if *in arguendo*, Fänger et al. had taught a stick preparation which lacked only a modified phyllosilicate pigment particle, there is no teaching or suggestion from the prior art to isolate this one component from the Msika et al. reference and insert it into the Fänger et al. reference.

As indicated above, consideration of the references must be taken as a whole and reliance on the teaching of Bentone 38 from Msika et al. is similar to the improper picking and choosing standard cited above. However, the nature of Msika et al.'s invention only indicates that Bentone 38 is appropriate for combination with a synergistic mixture of titanium and/or zinc oxide particles; there is no indication that such an addition would be appropriate for combination with the hydrophilic starch esterified with one or more n-octenylsuccinate radical of Fänger et al.'s invention. Moreover, Msika et al., while teaching water-in-oil emulsions and that they can be in the form of sticks also clearly defines that their contemplated water-in-oil emulsions will have between 4 and 35% by weight of emulsifier with respect to the total weight of the emulsion (see col. 4, lines 35-37 of Msika et al.).

Even if it could be shown that such a combination is possible with a reasonable expectation of success, "can be combined" is not the proper standard for establishing *prima facie* obviousness. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990).

The examiner mentions an expectation of optimizing the stability of the water-in-oil emulsions and of potentiating the solar protection of the emulsion in her rejection. However, there is no indication that this teaching or suggestion came from the references themselves but is merely the examiner's presumption for combining the references. Moreover, optimization of conditions is only relevant when the prior art recognizes a particular element is a results-effective variable. MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or

Beiersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)." Neither Fänger et al. or Msika et al. recognize the modified phyllosilicate pigment particle as being a results effective variable.

Conclusion

Therefore, the applicants believe that the applicants claims are non-obvious in view of Fänger et al. and Msika et al. as:

- (1) The Fänger et al. and Msika et al. references merely confirm what was known in the art about the properties of water-in-oil emulsions when attempting to use them as stick preparations; properties which are not present in the applicants' claimed invention.
- (2) One of ordinary skill in the art is not directed to the applicants stick preparation as claimed minus the modified phyllosilicate pigment particle when considering the teaching of Fänger et al. as a whole and further would not be directed to combine Fänger et al. and Msika et al. even if the references could be combined;
- (3) There is no teaching, suggestion or motivation to combine the Fänger et al. and Msika et al. references in the manner presented by the examiner.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

Beiersdorf 637.2-HCL
100718-197
6713-Dr. Wi-ar

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (11 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 25 February 2004

By: Agata Gliniska
Agata Gliniska